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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,081	11/29/2004	Marc Maria Leo Jan LaFaille	13877/15501	9659
26646 7590 07/21/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER MAZUMDAR, SONYA				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,081

Applicant(s)

LAFAILLE, MARC MARIA LEO JAN

Examiner

SONYA MAZUMDAR

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-13,16 and 18 is/are rejected.
- 7) ☒ Claim(s) 10,14 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's amendments, see pages 2 and 3 in remarks filed April 29, 2008, with respect to claims 2, 4, 7, and 10, have been fully considered, and the rejections under 35 USC 112, 2nd paragraph have been withdrawn.
2. Due to the cancellation of claim 3, the objection of claim 3 has been withdrawn
3. Due to the cancellation of claim 15, the rejection of claim 15 under 35 USC 103(a) has been withdrawn.
4. Applicant's arguments with respect to the pending claims have been considered, but in light of amendments, are moot in view of the new grounds of rejection.

Furthermore, with respect to claims 13 and 16, specifically the "two or more processing stations", Kobayashi et al. teach printing a decorative layer by an injector (33) and printing an adhesive layer by various means beforehand (column 9, lines 24-45). Also, a carrier feeding device is taught to bring the carrier into contact with an object, to thereby transfer the layers of printing material onto the object. Therefore, the rejection is maintained in view of Kobayashi et al.

Response to Amendment

5. The addition of claims 17 and 18 has been acknowledged.

Claim Objections

6. Claim 13 is objected to because of the following informalities:

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In line 6, "material" should be changed to "medium". Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 13 is rejected under 35 U.S.C. 102(b) as being unpatentable by Kobayashi et al. (US 6,110,316)

Kobayashi et al. teach a device for printing objects (B) that comprises multiple processing stations (33) for printing a decorative material and an adhesive layer on a carrier (S), and a carrier feeding device (7, 8, 9) to bring the carrier into contact with the object, to thereby transfer the layers of printing material onto the object (abstract; column 3, line 55 – column 4, line 13; column 8, line 59 – column 9, line 45; Figures 6A and 6B).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1, 7, 8, 9, 10, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaFaille (WO 00/61376) in view of Tugwell (US 4,037,008).

With respect to claim 1, LaFaille teaches a method for printing objects, where an object (5) is provided with a print by transfer from ink layers (29) on a flexible carrier (2). The layers are transferred onto the object to be printed by .bringing the carrier together with the ink layers and the object into mutual contact by a pressing means (6), and by removing the object from the carrier after the transfer of the ink layers are complete (page 1, line 33 – page 2, line 36; page 4, line 13 – line 23; page 5, lines 33-35; Figure 3).

Although LaFaille teaches printing several colors onto an object, LaFaille does not teach providing multiple layers on a carrier to transfer onto an object, where one of the layers has been subjected to at least a partial curing treatment. However, it would have been obvious to do so, as Tugwell teaches partially curing layers to be transferred such that volatile solvents are evaporated from the

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layers and the layers itself are not tacky at room temperature (column 5, lines 44-58; column 8, lines 51-64).

With respect to claim 7, LaFaille in view of Tugwell teaches ink layers (29) on top of a carrier (2) to be transferred onto an object (LaFaille: page 1, line 35 – page 2, line 6).

With respect to claim 8, LaFaille in view of Tugwell teaches an adhesive layer, i.e. absorbing printing medium, over an ink layer to provide for a good adherence to an object to which it is transferred from a carrier (Tugwell: abstract).

With respect to claim 9, LaFaille in view of Tugwell teaches using a frame, i.e. flat carrier, to support the carrier (LaFaille: page 7, lines 13-24).

With respect to claim 11, LaFaille in view of Tugwell teaches that during the transfer of ink layers, a carrier (2) is brought into contact with means (8) forming a support for the carrier around the object to be printed and provide for clamping of the carrier by bolts (7) (LaFaille: page 5, lines 14-19; Figure 3).

With respect to claim 12, LaFaille in view of Tugwell teaches that during the transfer of ink layers onto an object, a carrier (2) is brought into contact with a chamber-shaped part (20) which is open at one side, such that the open side is sealed by the carrier and a chamber is formed in which a pressure can be created with the purpose of assisting in pressing the carrier around the object (LaFaille: page 6, line 33 – page 7, line 2; Figure 1).

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11. Claims 2, 4, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaFaille in view of Tugwell as applied to claim 1 above, and further in view of Pointon (US 4,391,853) and Jones et al. (US 4,233,358).

The teachings of claim 1 are as described above.

LaFaille fails to teach subjecting an ink layer to a curing treatment before the application of another layer. Pointon teaches that ultraviolet radiation to cure a film is an alternative method to heat curing (Pointon: column 13, lines 38-42). Jones et al. teach partially curing each coating layer prior to application of a subsequent coating layer (Jones: column 1, lines 59-64; column 3, lines 41-43). It would have been obvious to one having ordinary skill in the art to incorporate these teachings so that the cured layers maintain only slight tackiness to a surface unless greater than finger pressure is applied, e.g. 50 p.s.i. (Pointon: column 9, lines 30-34).

12. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaFaille in view of Tugwell, as applied to claim 1 above, and further in view of Enlow et al. (US 6,254,712)

The teachings of claim 1 are as described above.

LaFaille in view of Tugwell fails to teach cleaning a carrier prior to the application of ink layers by a self-adhesive layer, and then subsequently removing the self-adhesive layer. However, Enlow et al. teach cleaning a carrier prior to coating by passing it through an anti-static vacuum station and a tacky roll web cleaner, comprising a pair of adhesive lint rolls (column 6, lines 4-8; column 35, lines 46-57; Figure 14). It would have been obvious to one having

ordinary skill in the art to clean a carrier prior to coating, as Enlow et al. teach, and would have been motivated to do so to remove airborne contaminants as well as macroscopic debris particles off the carrier.

13. Claim 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. as applied to claim 13 above, and further in view of LaFaille.

The teachings of claim 13 are as described above.

Kobayashi et al. fail to teach a printing device structured as a chamber-shaped part with an open side configured for sealing. However, it would have been obvious to do, as LaFaille teaches transferring ink layers onto an object, where a carrier (2) is brought into a chamber-shaped part (20) with a side opening, such that the open side is configured for sealing, and the chamber creates pressure with the purpose of assisting in pressing the carrier around the object (page 6, line 33 – page 7, line 2; Figure 1).

Allowable Subject Matter

14. Claims 10, 14, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There are no teachings found in the prior art of a method to transfer ink layers to objects that comprises moving a plurality of carriers carrying ink layers along a closed circuit, comprising different processing stations and a printing device. Also, there are no teachings found in the prior art of a printing device comprising a moving, rotating table in which several carriers are provided, such

that by systematically rotating the table, the carriers end up into processing stations and the actual printing device.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SONYA MAZUMDAR whose telephone number is (571)272-6019. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on (571) 272-1095. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SM

***/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791***